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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,679	07/03/2003	Chris R. Roberts	281_390NP	7356
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WALL MARJAMA & BILINSKI 101 SOUTH SALINA STREET SUITE 400 SYRACUSE, NY 13202				
			EXAMINER SMITH, PHILIP ROBERT	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/613,679

Applicant(s)

ROBERTS ET AL.

Examiner

Philip R. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 25-30 & 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-24 and 31-33 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20 Nov 2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION***

***Election/Restrictions***

- [01] Applicant's election with traverse of claims 1-24 in the reply filed on 26 May 2005 is acknowledged. Groups I (1-24) and III (31-33) will be combined and jointly examined.

***Claim Objections***

- [02] Claim 13 is objected to because of the following informalities: "said batteries" lacks antecedence in claim 11, which recites "at least one battery." Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

- [03] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- [04] Claims 1, 3, 7-9, 11-14, 16, 20-22, & 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Nussenbaum (5,542,905), patented 6 August 1996.

- [05] With regard to claims 1, 11-12, & 14: Nussenbaum discloses

[05a] a medical diagnostic instrument including a housing which is also a handle (comprising "battery case 5," "bottom cap 2," column2/ lines50-58 & "head assembly," column3/ lines3-8) containing at least one battery ("batteries 4")

and including a lamp assembly having at least one electrical contact (comprising "lamp 7," "sliding blade sleeve 8," & "mounting sleeve 21," 3/44-55);

[05b] a switch assembly for said medical diagnostic instrument including at least one movable member ("blade 51," 2/59-3/2) engagable with said lamp assembly to move said lamp assembly from a first position in which said electrical contact and said batteries are in electrical connection ("depressed downwards" state, 3/44-55) and a second position in which a spacing is formed between said battery and said electrical contact of said lamp assembly.

[05c] Additionally, "spring 28" (3/33-36) is disclosed by Nussenbaum as a movable member engagable with said lamp assembly to move said lamp assembly from a first position in which said electrical contact and said batteries are in electrical connection ("depressed downwards" state, 3/44-55) and a second position in which a spacing is formed between said battery and said electrical contact of said lamp assembly.

[06] With regard to claims 3 & 16: The movable member disclosed by Nussenbaum ("blade 51") is a lever including an exterior portion that is accessible to a user.

[07] With regard to claims 7 & 13: The battery disclosed by Nussenbaum is biased into electrical connection by a spring ("first electrical contact 3"). The movable member disclosed by Nussenbaum ("spring 28") acts to counteract the biasing force of said

spring.

- [08] With regard to claim 8: It is clear from Fig.1 that the instrument disclosed by Nussenbaum includes a pair of vertically stacked batteries.
- [09] With regard to claim 9: The movable member disclosed by Nussenbaum ("blade 51") is capable of being secured in either position.
- [10] With regard to claims 20-21: As noted above, the housing disclosed by Nussenbaum includes a handle ("battery case 5"). Nussenbaum additionally discloses a sleeve member ("separate housing 1") which is replaceably attached on the exterior of said handle.
- [11] With regard to claims 22 & 24: The "head assembly" (3/3-8) disclosed by Nussenbaum additionally comprises an instrument head which is releasably fastened to said housing by a threaded connection in an aligned manner relative to said switch assembly. It has been noted above that the light source is supported in said housing.

***Additional Claim Rejections - 35 USC § 102***

- [12] Claims 1-2, 9, 11-12, 14-15, & 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (6,679,616), published 22 November 2001.
- [13] With regard to claims 1, 11-12, & 14: Miller discloses
- [13a] a medical diagnostic instrument including a handle (comprising "casing 1," "cap 3," and "rear closure 6," 3/11-15) containing at least one battery ("battery B," 2/66) and including a lamp assembly having at least one

electrical contact (comprising "lamp 2," "base of the flashlight lamp 9,"  
3/22);

[13b] a switch assembly for said medical diagnostic instrument including at least one movable member ("back wall 7 of the rear cap 6," 3/16-22) engagable with said battery to move said battery from a first position in which said electrical contact and said batteries are in electrical connection ("depressed or forced inwardly" state, 3/17) and a second position in which a spacing is formed between said battery and said electrical contact of said lamp assembly.

[14] With regard to claims 2 & 15: Miller discloses that the movable member "may be fabricated of any type of resilient polymer," (3/13).

[15] With regard to claim 9: The movable member disclosed by Miller is capable of being secured in either position.

[16] With regard to claims 22-23: Miller discloses an instrument head ("cap 3" with "aperture 4," 3/3-5) which retains the disclosed light source and is releasably attachable to the housing. The disclosed instrument head retains the disclosed light source (through "aperture 4") and the disclosed switch assembly causes selective movement of said batteries relative to an electrical contact of said light source to cause energization and deenergization thereof after said at least one instrument head is attached to said housing.

***Claim Rejections - 35 USC § 103***

- [17] The text of those sections of Title 35, U.S. Code The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- [18] Claims 1-4, 6, 9-13, 14-19, 22, & 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin (2003/0195391), published 16 October 2003, in view of McRoskey (3,400,236), patented 3 September 1968.
- [19] Shin discloses a handle containing a battery ("handle grip 2 ... contain[ing] dry cells therein," [0024]) which inherently comprises a handle with a replaceable sleeve member on the exterior, a lamp assembly (comprising "bulb 4," [0026]), which inherently has at least one electrical contact, and a movable member which determines electrical contact between the battery and the lamp assembly ("On-Off switch 6," [0024]).
- [20] Shin does not disclose the particularities of the switch assembly including movable member recited by the applicant. Shin does not disclose the particularities of the at least one battery and lamp assembly with regard to their position, manual disposition, or biasing.
- [21] With regard to claims 1-2, 6, 11-12, 14-15, & 19: McRoskey discloses a battery

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("battery 32" having "central electrode contact 33 at one end," 3/70-75) and a lamp assembly (comprising "resilient contact 38" with "free end 39," 4/1-13; analogous structures labeled 38' and 39' provide electrical contact to a "light bulb device...46" in alternate embodiments). McRoskey further discloses a switch assembly including at least one movable member (comprising "extending projection 44," "slide member 40," and "projection 41" with "bevelled edge 43," 4/14-34) engagable with both the battery and the lamp assembly to move the battery and lamp assembly from a first position in which said electrical contact and said batteries are in electrical connection to a second position in which a spacing is formed between said battery and said electrical contact of said lamp assembly. McRoskey states in 4/26-29 that said switch assembly may be a single plastic injection molded part. The "bevelled edge 34" anticipates an angled surface, said movable member being movable so as to selectively interpose said angled surface between the top of said at least one battery and the electrical contact of said lamp assembly to selectively create a gap therebetween.

[22] With regard to claims 1-4, 11-12, 14-18: McRoskey discloses a battery ("battery 32" having "central electrode contact 33 at one end," 3/70-75) and a lamp assembly (comprising "contact 38'," 4/60 & "light bulb device...46," 4/40-41 ). McRoskey further discloses a switch assembly including at least one movable member (comprising "upstanding tubular sleeve 50," 4/47-51, "outer sleeve member 54" having "notch forming edges 56 and 57," 4/63-66, and "radially extending handle 58," 4/67-68) including a retaining cylindrical band ("outer sleeve



member 54") engagable with both the battery and the lamp assembly to move the lamp assembly from a first position in which said electrical contact and said batteries are in electrical connection to a second position in which a spacing is formed between said battery and said electrical contact of said lamp assembly. McRoskey states in 4/26-29 that said switch assembly may be a single plastic injection molded part. The "radially extending handle 58" anticipates a lever including an exterior portion that is accessible to a user. This lever is pivotally disposed (about "base contact 47," 4/46-48) between the top of said at least one said battery and the electrical contact of said lamp assembly.

- [23] At the time of the invention, it would have been obvious to a person of ordinary skill in the art that in reduction to practice, Shin's medical diagnostic instrument comprising a battery, a lamp assembly, and a switch assembly, be modified to assume the particularities of the switch assembly disclosed by McRoskey. This might be done in order to "provide switch contacts embodying a coiled spring in which the coils operate to effect self cleaning of the contacts" (1/56-58).
- [24] With regard to claims 9-10: The movable member disclosed by McRoskey is capable of being secured in either position. McRoskey further discloses a detent mechanism ("internal cavity 36," 4/1-9) for securing said movable member in at least one of said positions.
- [25] With regard to claim 13: The at least one battery disclosed by McRoskey is inherently biased into electrical contact with the lamp assembly.

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- [26] With regard to claims 22: Shin discloses an instrument head releasably attachable to said housing wherein said light source is supported in said housing.

***Allowable Subject Matter***

- [27] Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter.
- [28] Claim 5 requires the selective movement of the at least one battery relative to the electrical contact of the lamp assembly. This alone is not allowable subject matter, as evidenced by the rejection of claim 23. Unlike claim 23, claim 5 additionally requires a biasing force *toward the electrical contact*, which must be overcome, that is to say *counteracted upon*, by the movable member included in the switch assembly. Miller incorporates a a directional bias which is counteracted by the movable member, but the directional bias is *away from the electrical contact*, which is to say, in favor of deenergization. Claim 5 is therefore allowable over Miller, whereas claim 23, as written, is anticipated.

***Conclusion***

- [29] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Blakesley (2,254,347) and Bolley (2,332,554) present switches which interpose non-conductors between two electrical contacts. Newman (4,147,163) discloses an otoscope with a rheostat interposes between a

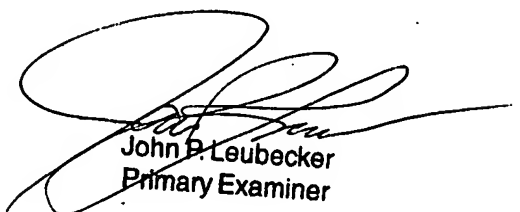
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lamp assembly and two vertically stacked batteries. Riester (4,366,811) discloses an otoscope with a spring biased switch that selectively contacts the lamp assembly.

- [30] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R Smith whose telephone number is (571) 272 6087. The examiner can normally be reached on 10:00-6:00.
- [31] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
- [32] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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John P. Leubecker  
Primary Examiner